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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,631	08/16/2001	Quintin T. Phillips	10007611-1	6321

7590 05/29/2008
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

ROBINSON, MYLES D

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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05/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/932,631	Applicant(s) PHILLIPS ET AL.	
	Examiner Myles D. Robinson	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 16, 24, 26, 30 - 33, 35 - 37 and 39 - 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 - 16, 32, 33 and 39 - 42 is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 8, 24, 26, 30, 31 and 35 - 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 1/22/2008, and has been entered and made of record. Currently, **claims 1, 3 – 16, 24, 26, 30 – 33, 35 – 37 and 39 – 42** are pending.

Response to Arguments

2. Applicant's arguments (see *Remarks 1/22/2008*) with respect to **claims 1, 9 and 41** have been fully considered and are persuasive. The rejections of these claims have been withdrawn.

3. Also, the Examiner attempted to contact the Applicant on 5/20/2008 and 5/21/2008 in order to facilitate prosecution of the instant application and to propose an Examiner's amendment. However, the Examiner could not reach the Applicant.

Claim Rejections - 35 USC § 112

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. **Claims 1, 3 – 8, 24, 26, 30, 31 and 35 – 37** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 1 recites the broad recitation "comparing the received consumable identifier with **at least one** of the stored consumable identifiers", and the claim also recites "comparing the received consumable identifier with **a plurality** of the stored consumable identifiers" which is the narrower statement of the range/limitation.

Use of a narrow numerical range (i.e. a plurality wherein at least two or more) that falls within a broader range (i.e. at least one which is inclusive of at least two or more) in the same claim may render the claim indefinite when the boundaries of the claim are not discernible. A narrower range or preferred embodiment may be set forth in another independent claim or in a dependent claim. If stated in a single claim,

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examples and preferences lead to confusion over the intended scope of the claim. In those instances where it is not clear whether the claimed narrower range is a limitation, a rejection under 35 U.S.C. §112, second paragraph should be made. See MPEP 2173.05(c)(I).

All claims dependent upon these claims suffer the same deficiency and, therefore, are rejected as well.

Allowable Subject Matter

6. ***Claim 1*** would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

7. ***Claims 9 – 16, 32, 33 and 39 – 42*** are allowed.

Referring to **claims 1, 9 and 41**, although the Applicant discloses that an alternative sequence of comparisons is possible wherein the sequence of comparisons does not effect the intended results and wherein the particular sequence of **first** comparing the consumable identifiers and then comparing the party identifiers **second** has no disclosed benefit or advantage (*see Specification [page 14, lines 21 - 30]*), the innovative limitation that distinguishes the Applicant's claim is comparing the received consumable identifier with the stored consumable identifier **before** the comparison of the received party identifier with the stored party identifier.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Phillips et al. (U.S. Patent No. 6,332,062 and German Patent No. 100 42 914 A1) discloses a method for customizing user messages in a printing system (see *Abstract*).

Suliman et al. (U.S. Patent Application Publication No. 2001/0053980) disclose a method for blind electronic warranty registration (see *Abstract*).

Pederson et al. (U.S. Patent Application Publication No. 2002/0133425) disclose an electronic product registration system with customizable return/warranty programs (see *Abstract*).

Siegel et al. (U.S. Patent Application Publication No. 2003/0069750) disclose a system for automatic device registration (see *Abstract*).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571)272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Myles D. Robinson/
Examiner, Art Unit 2625
5/22/08

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/Twyler L. Haskins/
Supervisory Patent Examiner, Art Unit 2625